REMARKS:

In the Final Office Action mailed April 6th, 2004, Claims 1-11 were rejected as being unpatentable over Dellinger et al. (U.S. Pat. No. 6,222,030), Crameri et al. (U.S. Pat. No. 6,376,246) and Manoharan et al. (U.S. Pat. No.6,207,819).

STATEMENT REQUIRED TO ESTABLISH COMMON OWNERSHIP (UNDER MPEP §706.02(l)(2) ):

Without acquiescing to the Examiner's arguments related to the patentability of the current claims over the cited art, Applicants now state that current invention (as reflected in the current application and claims) and the Dellinger et al. patent (U.S. Pat. No. 6,222,030) were, at the time the invention was made, subject to an obligation of assignment to the same person(s), i.e. the Regents of the University of Colorado and Hewlett-Packard Company, jointly. The obligation of assignment derives from an agreement in place on the date of invention and signed on behalf of both the Regents of the University of Colorado and Hewlett-Packard Company stating that jointly invented subject matter would be jointly owned. Agilent Technologies, Inc. is the successor-in-interest to Hewlett-Packard Company.

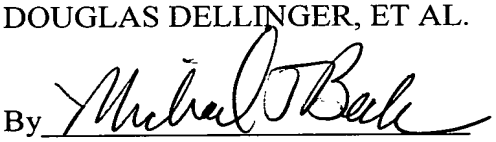
FURTHER REMARKS:

Since the Dellinger et al. patent and the current invention were commonly owned by the same person(s) at the time the current invention was made, the Dellinger et al patent is not available as prior art for the purposes of §103 for determining obviousness. Since the previous arguments made in the Office Action mailed on September 9, 2003 relied on the Dellinger et al. patent to establish a case for obviousness, there is no longer any reason of record for maintaining a holding of obviousness. Applicants therefore request withdrawal of the rejection and swift passage of the case to allowance.

Each of the present claims is directed to a method of synthesizing a polynucleotide and requires "(a) coupling a second nucleoside to a first nucleoside through a phosphite linkage, wherein the second nucleoside has a non-carbonate protecting group protecting a hydroxyl" and "(b) exposing the product of step (a) to a composition which concurrently oxidizes the phosphite formed in step (a) to a phosphate and deprotects the protected hydroxyl of the second nucleoside." Neither Crameri nor Manoharan, alone or in combination, show or suggest the elements of the current claims. Therefore, no prima facie case of obviousness has been established.

For the above reasons, the rejections of record are thought to be overcome, and the remaining claims allowable. Applicants request a timely Notice of Allowance for the remaining claims. If there are any unresolved issues that may be resolved via a phone call, the Examiner in charge of this case is invited to phone the undersigned attorney.

Respectfully submitted,
DOUGLAS DELLINGER, ET AL.

By 
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